

Attorney Docket No. 129969

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**In Re Application of:** : **Group Art Unit: 3661**  
**Narendra D. JOSHI et al.** : **Confirmation No: 1869**  
**Serial No.:** 10/604,870 : **Examiner: BROADHEAD, Brian J.**  
**Filed:** August 22, 2003 :  
**For:** **METHOD AND APPARATUS FOR RECORDING AND RETRIEVING**  
**MAINTENANCE, OPERATING AND REPAIR DATA FOR TURBINE**  
**ENGINE COMPONENTS**

**REPLY BRIEF**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

This is a REPLY BRIEF offered in response to the EXAMINER'S ANSWER dated April 10, 2007, in reply to the APPELLANTS' BRIEF in an appeal from the final rejection dated February 10, 2006, of claims 1-29 of the captioned application.

## **ARGUMENTS**

The Examiner's Answer continues to fail to refute Appellants' arguments in support of patentability of Appellants' invention, and also raises a further issue not properly addressed in the Final Rejection dated 10 February 2006.

At the top of page 17 of Examiner's Answer, the Examiner raises the point that Katayanagi et al. may be non-analogous. The prior art reference used in an obviousness rejection must either be in the applicant's field of endeavor, or be reasonably pertinent to the particular problem with which the applicant was concerned. Applicants believe that Katayanagi et al. is non-analogous.

Applicants note that there is no mention or determination made of in any of the office actions of the applicant's field of endeavor or of the particular problem with which the applicant was concerned. The Examiner has not mentioned "field of endeavor" in the Examiner's Answer. Indeed, Applicants believe that Katayanagi et al. is outside the Applicants' field of endeavor of turbine engine repair and maintenance.

The only mention of the particular problem with which the applicant was concerned, is found in the Examiner's Answer at page 17, about line 6:

"In this case, the particular problem that Applicant tries to solve is that the information provided in the tags of the prior art is not sufficient".

Applicants believe that this is NOT a proper statement of the problem. It is too vague, and too general.

One might be tempted to define Applicant's problem as "obtaining information on the part level of a component of a turbine engine". However, Applicants believe that this statement of the problem would be inappropriate, since it would merely recite Applicant's solution. In *Monarch Knitting Machinery Corp. v. Sulzer Morat GmbH* (139 F.3d 887, 45 USPQ2d 1977 (Fed Cir 1998), the district court formulated the problem in terms that presumed the solution to the problem. The Court of Appeals for the Federal Circuit held that defining the problem in terms of its solution was held to be improper hindsight in the selection of the prior art relevant to the obviousness.

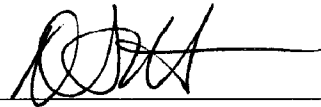
Consequently, there is no objective evidence in the record that a proper statement of the Applicants' problem has ever been formulated. Applicants assert that there is sufficient evidence present in the record to establish that the Katayanagi et al. reference is not reasonably pertinent to the particular problem with which the Applicant was concerned, and that therefore, both rejections should be withdrawn. On the contrary, according to the record, only after the Applicant had provided to the Examiner an explanation of Applicant's solution as claimed (that is, to identify and store part information on at least one part of an engine component), as evidenced by the Interview Summary of November 9, 2005, did the Examiner formulate a search that looked specifically for art that included any one of "part", "component", or module". (See the attached Examiner's Search Strategy and Results). Applicants have determined that Katayanagi et al. does not mention either component or module, or engine or turbine, in the context and meaning used in Applicants' description and claims (Katayanagi et al. mentions "component" as a sub-element of a part.). There is no evidence in the record that the Examiner formulated a search strategy based upon the problem addressed by the Applicant, without resorting to the specific solution invented by the Applicants.

**CONCLUSION**

The Examiner is believed to have used improper hindsight in the selection of the prior art (namely, Katayanagi et al.) relevant to the issue of obviousness and therefore has improperly rejected the appealed claims based on such non-analogous prior art.

The grounds of rejection of the claims set forth in the Examiner's Action dated 10 February 2006 being therefore without merit and failing to support a *prima facie* case of obviousness of Appellants' invention, it is respectfully requested that the Honorable Board reverse the Examiner's rejection of the claims.

Respectfully submitted,



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June 7, 2007